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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/342,408
Filing Date: June 28, 1999
Appellant(s): ONG, PING-WEN

Kevin M. Mason
For Appellant

EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed on 11/03/2003 of the appeal brief filed on 05/19/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the supplemental brief is correct.

(7) *Grouping of Claims*

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The rejection of claims 1-25 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief (or Appendix I or the Supplemental Appeal Brief) is correct.

(9) *Prior Art of Record*

5,991,773	TAGAWA	11-1999
5,978,847	KISOR ET AL.	11-1999
5,991,802	ALLARD ET AL.	11-1999
5,946,699	SAWASHIMA	08-1999
5,832,478	GEORGE	11-1998

Kolb-Proust Archive, "Search the Kolb-Proust Archive Documents",
<http://gateway.library.uiuc.edu/kolbp/Search1.html>, copyright 1997, pages 1-16.

Compose Search, "How to Compose a Search", copyright 1997, pages 1-2.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 9, 11-12, 21 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding dependent claims 9 and 21, which is dependent on claim 1 and 13 respectively. Claims 9 and 21 recite the limitation of “displaying a list of the web resources”. There is insufficient antecedent basis for this limitation in the claims.

Regarding dependent claims 11 and 23, which is dependent on claim 10 and 22 respectively. Claims 11 and 23 recite the limitation of “displaying a list of said versions”. There is insufficient antecedent basis for this limitation in the claims.

Regarding dependent claims 12 and 24, which is dependent on claim 11 and 23 respectively. Claims 12 and 24 recite the limitation of “displaying said list of links”. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1-3, 5-6, 13-15, 17-18 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa, US 5,991,773, filed 04/1997.

Regarding independent claim 1, Tagawa teaches the steps of:

- receiving a request for an electronic document, said request including a variable time-stamp (Tagawa, col.2, line 54 – col.3, line 20, receiving an Uniform Resource Locator (URL) request including a variable time stamp indicating a time creating version from terminal unit via network); and
- identifying versions of said electronic document corresponding to said variable time-stamp (Tagawa, col.2, line 54 – col.3, line 20).

Regarding dependent claim 2, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa teaches wherein an address identifying said electronic document includes said time-stamp (Tagawa, col.2, line 54 – col.3, line 20 and col.10, lines 47-49, URL address includes time stamp 950910).

Regarding dependent claim 3, which is dependent on claim 2, Tagawa teaches the limitations of claim 2 as explained above. Tagawa teaches wherein said address is a Uniform Resource Locator ("URL") (Tagawa, col.2, line 54 – col.3, line 20 and col.10, lines 47-49, requesting address includes time stamp 950910 is Uniform Resource Locator ("URL")).

Regarding dependent claim 5, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa teaches wherein said request is specified using a browser (Tagawa, col.5, lines 5-30; and col.6, lines 10-17, wherein end user send GET URL request to a server for desired web document; and the requested document is sent through HTTP protocol and displayed on the terminal of the user).

Regarding dependent claim 6, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa teaches wherein said request includes a relative time stamp (Tagawa, col.7, lines 28-30).

Regarding independent claim 13, claim 13 is for a computer system performing the method of claim 1, and is rejected under the same rationale. Tagawa teach the method of claim 1 as explained above. This inherently disclose that Tagawa's system must have a memory and processor to implement the method of claim 1, since the system is computer system and used on the web. Tagawa teaches the system have a memory for storing said multiple version of said electronic document in an archive of electronic documents; and a processor operatively coupled

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to said memory (Tagawa, summary), said processor configured to performing method claim 1 as explained in claim 1 above.

Claims 14-15 and 17-18 are for a computer system performing the method of claims 2-3, and 5-6, respectively and are rejected under the same rationale.

Claim 25 is for an article of manufacture comprising computer readable medium performing the method of claim 1, and is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tagawa as applied to claims 3 and 15 above, and further in view of Kisor et al., US

5,978,847 filed 12/1996.

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Regarding dependent claim 4, which is dependent on claim 3, Tagawa teaches the limitations of claim 3 as explained above. Tagawa does not explicitly disclose wherein said Uniform Resource Locator (“URL”) has an associated request header for indicating said variable time stamp.

Kisor discloses that the URL has an associated request header for indicating a time stamp (Kisor, col.3, line 50 – col.4, line 20; and col.7, line 21-25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Kisor and Tagawa to allow the client to retrieve desired Web information based on the time stamp, since it would have helped to retrieve document using HTTP request in a network environment.

Claim 16 is for a computer system performing the method of claim 4, and is rejected under the same rationale.

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa as applied to claims 3 and 15 above, and further in view of Allard et al., US 5,991,802 filed 11/1996.

Regarding dependent claim 4, which is dependent on claim 3, Tagawa teaches the limitations of claim 3 as explained above. Tagawa does not explicitly disclose wherein said Uniform Resource Locator (“URL”) has an associated request header for indicating said variable time stamp.

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Allard discloses that the URL has an associated request header for indicating additional information about the request (Allard, col.1, lines 50-60).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Allard and Tagawa to allow the client to retrieve desired Web information based on the time stamp, since it would have allowed the user/client to pass additional information such as time stamp in the request header in a network environment.

Claim 16 is for a computer system performing the method of claim 4, and is rejected under the same rationale.

Claims 8-9 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa as applied to claims 1 and 13 above, and further in view of Sawashima et al., US 5,946,699 filed 08/1997.

Regarding dependent claim 8, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. However, Tagawa does not explicitly disclose wherein said variable time-stamp includes a date range.

Sawashima teaches performing search for data within the time range designated by the user (Swashima, col.2, lines 59-61; and col.11, lines 44-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sawashima and Tagawa to provide many ways for the users to specify their request, since this would have allowed a user requests an electronic

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document/documents or a version/versions of electronic document with a specific time or within a time range.

Regarding dependent claim 9, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa does not explicitly teach displaying a list of web resources that satisfy said variable time stamp. Refer to the rationale relied to reject claim 8, the combination of Tagawa and Sawashima teaches that a user is able to request a version/versions of electronic document within a date range in a network environment as explained above.

Sawashima also teaches transferring search results that satisfy the search request to the requested users (Sawashima, col.11, lines 44-55).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sawashima and Tagawa to provide the user a list of web resources/versions of an electronic document that satisfy a request for these resources/versions of an electronic document within a time range.

Claims 20-21 are for a computer system performing the method of claims 8-9, respectively and are rejected under the same rationale.

Claims 8-9 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa as applied to claim 1 above, and further in view of "Search the Kolb-Proust

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Archive Documents” (herein after Kolb-Proust Archive, <http://gateway.library.uiuc.edu/kolbp/Search1.html>, copyright 1997, pages 1-16.

Regarding dependent claim 8, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. However, Tagawa does not explicitly disclose wherein said variable time-stamp includes a date range.

Kolb-Proust Archive teaches performing search for electronic documents contain data within a time range designated by the user in the Internet (Kolb-Proust Archive, page 2 and page 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Kolb_Proust Archive and Tagawa to provide many ways for users to specify their request, since this would have allowed a user requests an electronic document/documents or a version/versions of electronic document with a specific time or within a time range.

Regarding dependent claim 9, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa does not explicitly teach displaying a list of the web resources that satisfy said variable time stamp. Refer to the rationale relied to reject claim 8, the combination of Kolb-Proust Archive and Tagawa teaches that the users are able to request a version/versions of electronic document within a date range in a network environment as explained above.

Kolb-Proust Archive also teaches displaying a list of web resources that satisfy the date range (Kolb-Proust Archive, page 2-3).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Kolb-Proust Archive and Tagawa to provide a list of web resources that satisfy the search request, since it is common sense that the search results should be provided to the user.

Claims 20-21 are for a computer system performing the method of claims 8-9, respectively and are rejected under the same rationale.

Claims 7, 10 and 19, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa as applied to claims 1 and 13 above, and further in view of George, US 5,832,478, filed 03/1997.

Regarding dependent claim 7, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa does not explicitly teach wherein said variable time-stamp includes a wildcard character.

However, it is well known in the art at the time the invention was made that the use of wild-card characters in a search request are useful for indicating unknown component in a search. As George discloses the wild-card characters are used to specify single or zero to many alphanumeric character in matching search string (George, col.2, lines 44-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined George and Tagawa to provide many ways to specify a search request, such as request a version/versions of an electronic document having specific or

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unknown time using wild-card characters, since using wild-card characters, such as '?' and '*' within the variable time-stamp would have been useful for indicating meaning in search request.

Regarding dependent claim 10, which is dependent on claim 1, Tagawa teaches the limitations of claim 1 as explained above. Tagawa does not explicitly teach wherein said variable time-stamp can be utilized to identify a version of said electronic document having an unknown time.

However, it is well known in the art at the time the invention was made that the use of wild-card characters in a search request are useful for indicating unknown component in a search. As George discloses the wild-card characters are used to specify single or zero to many alphanumeric character in matching search string (George, col.2, lines 44-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined George and Tagawa to provide many ways to specify a search request, such as request a version/versions of an electronic document having specific or unknown time using wild-card characters, since using wild-card characters, such as '?' and '*' within the variable time-stamp would have been useful for indicating meaning in search request.

Claims 19 and 22 are for a computer system performing the method of claims 7 and 10, respectively and are rejected under the same rationale.

Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa and George as applied to claims 10 and 22 above, and further in view of "Search the Kolb-Proust

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Archive Documents” (herein after Kolb-Proust Archive, <http://gateway.library.uiuc.edu/kolbp/Search1.html>, copyright 1997, pages 1-16.

Regarding dependent claim 11, which is dependent on claim 10. Refer to the rationale relied to reject claim 10, the combination of Tagawa and George teaches that the users are able to request a version/versions of electronic document using wild-card characters in a network environment as explained above. Tagawa does not explicitly teach the step of displaying a list of versions satisfying said variable time stamp.

Kolb-Proust Archive teaches displaying a list of documents that satisfy the date range (Kolb-Proust Archive, page 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Kolb-Proust Archive and Tagawa to provide a list of versions that satisfy the search request, since it is common sense that the search results should be provided to the user.

Claim 23 is for a computer system performing the method of claims 11, and is rejected under the same rationale.

Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa and George and further in view of Kolb-Proust Archive as applied to claims 11 and 23 above, and further in view of “How to Compose a Search” (herein after Compose Search), copyright 1997, pages 1-2.

Regarding dependent claim 12, which is dependent on claim 11, Tagawa, George, and Kolb-Proust Achive teach the limitations of claim 11 as explained above. Tagawa does not explicitly disclose the step of displaying a list of links in an order specified by a user.

Kolb-Proust Achive teaches display a list of links that satisfy the date range in a search result (Kolb-Proust Achive, pages 2-9, the search result includes 5 links (URLs), a document will be shown in page 8 when selecting a link in the search result).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Kolb-Proust Archive and Tagawa to provide a list of links of web resources that satisfy the search request, since it is common sense that the search results should be provided to the user.

However, Kolb-Proust Achive does not explicitly disclose displaying a list of links *in an order specified by a user*.

Compose Search teaches sorting a list of search result that is specified by a user (Compose Search, page 2, second paragraph from the bottom).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Compose Search into Kolb_Proust Archive and Tagawa to organize the display of search result at the user's desires or needs, since Compose Search's sorting would have allowed the user to specify the display of the list of search result.

Claim 24 is for a computer system performing the method of claims 12, and is rejected under the same rationale.

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(11) *Response to Argument*

“Information Disclosure Statement”

The corrected Information Disclosure Statement filed on 10/31/2003 that includes an explicit fee authorization has been considered by examiner.

“Section 112 Rejections”

Appellant argues that while claim 1-7 were rejected under 35 U.S.C §112, second paragraph, examiner address claims 9, 11-12, 21, 23-24 is insufficient antecedent basis for these limitations in the claims. “Appellant believes that the Examiner intended to reject claims 9, 11-12, 21, 23-24” (Supplemental Appeal Brief, page 3, lines 14-15). Appellant is **not** appealing the issue of whether claims rejected under 35 U.S.C §112, second paragraph are properly rejected and is requesting the entering of proposed amendments (Supplemental Appeal Brief, appendix II) after Appeal Board resolves the appealed issues.

Examiner agrees that there was a typographical error in the title of rejection under 35 U.S.C §112, second paragraph that claims 1-7 (instead of claims 9, 11-12, 21, 23-24) were rejected. However, examiner has clearly explained reasons to reject claims 9, 11-12, 21, 23-24 inside the body of the rejection under 35 U.S.C §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention so that the appellant has also recognized that examiner intends to reject claims 9, 11-12, 21, 23-24 instead of claims 1-7 (Supplemental Appeal Brief, page 3, lines 14-15). The request of entering of proposed amendments (Supplemental Appeal Brief, appendix II) after Appeal Board resolves the appealed issues is accepted.

“Independent Claims 1, 13, and 25”

On page 5 of the Supplemental Appeal Brief, Appellants’ argument focus solely around one point, that of “receiving a request for said electronic document, said request including a variable time-stamp” which Appellants argue Tagawa does not disclose or suggest.

Examiner disagrees. As discussed in the Office Action and clearly showed in Tagawa’s text, a user of Tagawa’s system provides a uniform resource locator (URL) in the request that includes a directory and a filename that contains the data to be retrieve (Tagawa, col.2 lines 57-62). This filename has a version number corresponding to a timestamp (date) at which the data is created or updated (Tagawa, col.3 lines 5-20). This said timestamp (date) is in fact a variable date that is associated with the data content in the file included in the user provided URL. The desired version of the data content is to be displayed when a (desired) version number (timestamp or date) is asked for (Tagawa, col.3 line 21-23). Tagawa’s discussion thus clearly teaches “receiving a request for said electronic document, said request including a variable time-stamp” that is claimed in the limitation of independent claims 1, 13 and 25.

“Additional Cited References”

The last paragraph on page 5 of the Supplemental Appeal Brief, Appellants state “Allard does address receiving a request for an electronic document (said request including a variable time-stamp)”. However, in conclusion section on page 7 of the Supplemental Appeal Brief, Appellants argue that Kisor et al., Allard et al., Sawashima et al., Kolb-Proust Archive, George and Compose Search, alone or in any combination, do not disclose or suggest “receiving a

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request for said electronic document, said request including a variable time-stamp” as required by independent claims 1, 13, and 25. Examiner assumes that Appellants’ point of view based on this conclusion. Appellants use abstract to conclude that Sawashima does not teaches the step of “receiving a request for said electronic document, said request including a variable time-stamp” on page 6, second paragraph of the Supplemental Appeal Brief.

Examiner disagrees. Appellants appear to have not read the cited references in full but only their abstracts. Examiner urges Appellants to read and follow the Office Action’s discussion instead to fully understand the reasons behind the claims’ rejections. Sawashima teaches version number range and date range (otherwise called variable time stamps) are included in a search request. Sawashima’s system then selects the corresponding data and includes them in the search results to be sent back to the system’s user. (Sawashima, col. 11 lines 44-51).

Kolb-Proust Archive also teaches including a variable date range (timestamp) within the search request for documents to be retrieved (Kolb, page 2 in search box).

“Dependent Claims”

On pages 7 through 8 of the Supplemental Appeal Brief, Appellants argue that Tagawa does not disclose, “an address identifying said electronic document includes said time-stamp” as required by dependent claims 2 and 14 wherein said time-stamp is reference the time-stamp of claims 1 and 13, which is a variable time-stamp.

As discussed above for independent claims 1, 13 and 25, the timestamp (date) is in fact a variable date that is associated with the data content in the file included in the user provided

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URL address (Tagawa, col.3, lines 5-20 and also see Tagawa's figure 10 and figure 11, box 116).

The desired version of the data content is to be displayed when a (desired) version number (timestamp or date) is asked for (Tagawa, col.3 line 21-23). Tagawa's discussion thus clearly teaches "an address identifying said electronic document includes said time-stamp" as required by dependent claims 2 and 14 wherein said time-stamp is reference the time-stamp of claims 1 and 13, which is a variable time-stamp.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

TVH
January 22, 2004



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